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UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

**THE ORB FACTORY LIMITED**, a Nova  
Scotia, Canada, Limited Company,

**Plaintiff,**

**v .**

**LISA FRANK, INC**, an Arizona corporation,

**Defendant.**

**Civil Action No. 1:15-cv-06110**

**COMPLAINT FOR DECLARATORY  
JUDGMENT OF NON-INFRINGEMENT  
AND UNPROTECTABILITY OF TRADE  
DRESS AND NON-INFRINGEMENT OF  
TRADEMARK**

**DEMAND FOR JURY TRIAL**

Plaintiff, The Orb Factory Limited (“Orb Factory”), brings this action for declaratory judgment against Defendant Lisa Frank, Inc. (“LFI”).LD

**PARTIES**

1.

Plaintiff is a corporation organized and existing under the laws of Nova Scotia, Canada, with a principal place of business at 225 Herring Cove Road, Halifax, Nova Scotia, Canada B3P 1L3.

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2.

Defendant is a corporation organized and existing under the laws of Arizona and has a principal place of business at 6760 S Lisa Frank Avenue, Tucson, Arizona 85756.

**JURISDICTION AND VENUE**

3.

Plaintiff seeks declaratory judgment of non-infringement of alleged trade dress rights asserted against Plaintiff by Defendant. Plaintiff further seeks declaratory judgment that the alleged trade dress rights asserted by Defendant are unprotectable and unenforceable.

4.

This action for declaratory judgment arises under the Trademark Laws of the United States, 15 USC §1051 *et seq.*

5.

The Court has jurisdiction over the subject matter of this action pursuant to 28 USC §1331 (federal question), 28 USC §1338(a) (trademarks) and 28 USC §2201 (Declaratory Judgment Act).

6.

The Court has personal jurisdiction over Defendant because Defendant transacts business within this forum.

7.

Venue is proper in this Court, pursuant to 28 USC § 1391(b), in that a substantial part of the events giving rise to the claims occurred in this district, and Defendant transacts business in this district.

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**GENERAL ALLEGATIONS**

8.

LFI has asserted that Orb Factory is infringing LFI's alleged trade dress rights by selling PlushCraft pillow craft kits. The craft kits utilize a punch to insert pieces of fabric into a die-cut openings in a template to form patterns that depict various animals (e.g. cats), various persons (e.g. princesses), and various objects (e.g. rainbows).

9.

On or about July 21, 2015, LFI sent the letter attached as Exhibit 1 to Plaintiff demanding:

(a) that Orb Factory immediately cease and desist from selling or offering or advertising for sale its PlushCraft pillow craft kit products;

(b) that Orb Factory provide an account to LFI of all sales for the purpose of enabling LFI to assess compensation to be paid by Orb Factory to LFI; and

(c) provide an inventory of allegedly infringing product to LFI with a proposal for withdrawal of the product from market and its destruction or surrender to LFI.

The letter further stated that compliance with the requests is necessary to avoid further action by Lisa Frank, Inc.

10.

There presently exists a justiciable controversy regarding Plaintiff's right to make and sell its PlushCraft pillow craft kit products. The dispute between Plaintiff and Defendant is definite and concrete.

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**FIRST COUNT**

**(Declaratory Judgment of Unprotectability of Alleged Trade Dress)**

11.

Plaintiff incorporates by reference its allegations set forth in paragraphs 1-10.

12.

LFI's designs are not sufficiently distinct to denote product source. The kinds of colors, shapes, and combinations thereof that LFI uses are common to "cute" renditions of owls, bears, penguins, rainbows, cupcakes, unicorns, and similar subjects. Cute renditions of animals, persons, and objects are routinely created and used in commerce by a multitude of industries. Therefore, LFI's works cannot be given exclusive rights under trade dress law.

13.

Plaintiff seeks a declaratory judgment that Defendant's alleged trade dress is not protectable under the trade dress laws of the United States.

**SECOND COUNT**

**(Declaratory Judgment of Non-Infringement of Alleged Trade Dress)**

14.

Plaintiff incorporates by reference its allegations set forth in paragraphs 1-13.

15.

Orb Factory has not used the patterns in its craft kits as trademarks or as trade dress.

16.

The patterns used by Orb Factory are substantially different than those used by LFI and there is no likelihood that customers would assume that Orb Factory products originate from LFI.

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17.

Plaintiff seeks a declaratory judgment that Plaintiff's PlushCraft pillow craft kits have not infringed and do not infringe Defendant's alleged trade dress.

**THIRD COUNT**

**(Declaratory Judgment of Non-Infringement of Trademark)**

18.

Plaintiff incorporates by reference its allegations set forth in paragraphs 1-16.

19.

Orb Factory produces a craft kit called the Orb Factory PlushCraft Puppy Love Pillow Kit. The kit consists of textile materials and instructions that enable a child to make a pillow having a rendition of a puppy.

20.

Orb Factory does not use the term puppy love as a trademark to denote the source of the product.

21.

LFI's letter alleges that Orb Factory is infringing a registered trademark of LFI for the term Puppy Love. LFI's registration for PUPPY LOVE encompasses paper goods, namely printed items for children.

22.

The Orb Factory PlushCraft Puppy Love Pillow Kit is not a paper good.

23.

Plaintiff seeks a declaratory judgment that it has not infringed and does not infringe Defendant's trademark.

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**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff respectfully requests that this Court:

- A. Declare that LFI's alleged trade dress lacks the requisite legal requirements to be protectable and to be enforceable; and
- B. Declare that Plaintiff's PlushCraft products have not infringed and are not infringing LFI's alleged trade dress rights;
- C. Declare that Plaintiff's PlushCraft products have not infringed and are not infringing LFI's alleged trademark rights; and
- D. Award Plaintiff's reasonable attorney fees and such other and further relief as this Court may deem just and proper.

**JURY DEMAND**

Plaintiff demands a trial by jury.

DATED this 4<sup>th</sup> day of August, 2015.

**/s/ Leonard D. DuBoff** \_\_\_\_\_

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